

Amendment After Final
Appl. No. 09/933,884
KPG 01134US
Page 12 of 14

REMARKS

The above-listed claim amendments along with the following remarks are fully responsive to the final Office Action set forth above. This Amendment places the application in condition for allowance, or in better condition for appeal. Entry of this Amendment and reconsideration of the application is requested.

The Examiner indicated that claims 65-75 and 88-95 would be allowable if rewritten in independent form. Claims 47, 66, 67, 76, 88, 89, 96, and 97 are amended in accordance with the Examiner's suggestion. No new matter is introduced into the application by the claim amendments. After entry of this Amendment, claims 47-98 are pending.

The present invention provides an imageable composition, an imageable element comprising the imageable composition, and a method of making the imageable element. The invention further provides a method of making an imaged element from an imageable element. The Abstract is amended to more accurately reflect the scope of the claims.

Each pending claim of the present application recites an imageable composition comprising an acid curable composition, an acid generator, and a specified colorant, wherein the colorant includes a counter anion derived from a non-volatile acid. Claim 47 is directed to an imageable composition, and is amended to recite that the composition further includes an infrared absorber or a photothermal converter material. Claim 76 is directed to an imageable element, and is amended to recite that the composition further includes an infrared absorber or a photothermal converter material, and that the colorant enhances the visual contrast between image areas and non-image areas after imaging of the imageable element. Claim 96 is directed to a method of making an imageable element, and is likewise amended.

Claim Rejections – 35 U.S.C. § 102

The Examiner rejected claims 47-64, 76-87 and 96-98 as anticipated by U.S. Patent 5,340,699 to Haley, *et al.* ("Haley"). The Examiner stated that Example 1 of Haley reports a composition comprising a resole resin, a novolak resin, an onium salt, and an infrared dye having a sulfonate counter ion. The Examiner equated the infrared dye of Haley with the colorant recited in the present claims. The Examiner therefore concluded that the composition reported in Example 1 of Haley anticipates the present claims.

BEST AVAILABLE COPY

Amendment After Final
Appln. No. 09/933,884
KPG 01134US
Page 13 of 14

Applicants disagree with the Examiner's position that the infrared dye is equivalent to the colorant recited in the present claims. As fully explained in a previous Amendment filed May 12, 2004, a colorant is characterized by significant absorption in the visible region, and functions to enhance contrast between image areas and non-image areas of an imaged element. The infrared dye used in Haley lacks a significant absorption in the visible region, and is inadequate for providing the required level of contrast between image areas and non-image areas of an imaged element. The person of ordinary skill in the art would not consider the infrared dye reported in Haley to be a "colorant" under the ordinary meaning of the term.

In the interests of expediting prosecution, however, the pending independent claims 47, 76, and 96 are amended to recite that the imageable composition further includes an infrared absorber or a photothermal converter material. The Examiner indicated that claims directed to such an imageable composition (e.g., claims 66 and 67) are allowable over the prior art of record.

Furthermore, claims 76 and 96 are amended to recite that the colorant enhances the visual contrast between image areas and non-image areas after imaging of the imageable element. Haley does not provide such a feature. Haley does not teach or suggest the use of a colorant having a significant absorption in the visible region, and having a counter anion derived from a non-volatile acid. In the compositions of Haley, a colorant is an optional additive:

As explained hereinabove, the four essential ingredients of the radiation-sensitive composition of this invention are a resole resin, a novolac resin, a latent Bronsted acid and an *infrared absorber*. Other ingredients which can optionally be incorporated in the composition include *colorants*, stabilizers, additional sensitizers, exposure indicators and surfactants. (Emphases added.)

See Haley, col. 6 at lines 15-21. In short, Haley reports the inclusion of an optional colorant in an imageable composition; Haley does not report an imageable composition comprising a colorant having a counter anion derived from a non-volatile acid, and further comprising an infrared absorber or a photothermal converter material.

In view of the foregoing, Applicants respectfully submit that claims 47-64, 76-87 and 96-98 are not anticipated by Haley. Withdrawal of the rejection is requested.

The Examiner rejected claims 47-64, 76-87 and 96-98 as anticipated by U.S. Patent 6,423,462 to Kunita ("Kunita"). The Examiner stated that Examples 1-4 to 1-8 and 2-4 to 2-8, as well as Comparative Examples 1-8 anticipate the claimed invention.

Amendment After Final
Appl. No. 09/933,884
KPG 01134US
Page 14 of 14

Applicants respectfully submit that claims 47-64, 76-87 and 96-98 are not anticipated by Kunita. As stated above, each of the rejected claims is amended to recite an imageable composition comprising an acid curable composition, an acid generator, and a colorant, wherein the colorant includes a counter anion derived from a non-volatile acid, and further comprising an infrared absorber or a photothermal converter material. The Examiner indicated that claims directed to such an imageable composition (e.g., claims 66 and 67) are allowable over the prior art of record. Furthermore, claims 76 and 96 are amended to recite that the colorant enhances the visual contrast between image areas and non-image areas after imaging of the imageable element.

The compositions of Kunita do not provide all the features of the claimed invention. Kunita cannot anticipate the present claims 47-64, 76-87 and 96-98, and withdrawal of the rejection is requested.

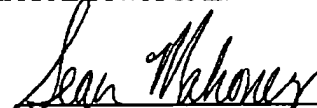
Conclusion

This Amendment places the application in condition for allowance, or in better condition for appeal, and entry of this Amendment and reconsideration of the application is requested. All claims are in condition for allowance, and a notice to that effect is respectfully solicited. If any outstanding issues remain in this case after consideration of this Amendment, the Examiner is invited to call the undersigned attorney in order to expedite further prosecution.

Respectfully Submitted,

ELI HAYAKAWA et al.

By:


Sean B. Mahoney, #57,984
FAEGRE & BENSON LLP
2200 Wells Fargo Center
90 South Seventh Street
Minneapolis, MN 55402-3901
612/766-6845

Dated: October 28, 2004

M2:20663967.01

Serial No.: 09/933,884

**This Page is Inserted by IFW Indexing and Scanning
Operations and is not part of the Official Record**

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ **BLACK BORDERS**
- ☐ **IMAGE CUT OFF AT TOP, BOTTOM OR SIDES**
- ☐ **FADED TEXT OR DRAWING**
- ☐ **BLURRED OR ILLEGIBLE TEXT OR DRAWING**
- ☐ **SKEWED/SLANTED IMAGES**
- ☐ **COLOR OR BLACK AND WHITE PHOTOGRAPHS**
- ☐ **GRAY SCALE DOCUMENTS**
- ☐ **LINES OR MARKS ON ORIGINAL DOCUMENT**
- ☐ **REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY**
- ☐ **OTHER:** _____

IMAGES ARE BEST AVAILABLE COPY.

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.